

REMARKS

This amendment is filed in response to the Office Action of August 16, 2007. Claims 23-34 are pending. Claims 30-34 are under consideration. Claim 30 has been amended to correct a typographic error. No new matter has been introduced. Reconsideration and allowance of the claims in view of the above amendments and the remarks that follow are respectfully requested.

REISSUE APPLICATIONS

The Examiner requested clarification of the assignment of US Patent No. 5,830,529, filed May 31, 2006. Applicant has enclosed herein a written consent (Exhibit 1) of the assignee of US Patent No. 5,830,529 in compliance with 37 CFR 1.172.

The Examiner also alleged that the amendment filed July 13, 2005 proposed amendments to the claims that do not comply with 37 CFR 1.173(b). Claims 23-34 have been amended to comply with 37 CFR §1.173(b).

The Examiner further alleged that the reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. Claims 30-34 are therefore rejected as being based upon a defective reissue oath under 35 U.S.C. §251.

In a telephone conference with Applicant's representative on November 5, 2007, the Examiner indicated that the deficiency arose under 37 C.F.R. §1.63 because Applicant has not submitted a copy of the executed oath or declaration filed in the parent application (i.e., Application No. 09/706,491. Applicant respectfully submits that the REISSUE DIVISIONAL OATH/DECLARATION submitted April 12, 2004 should satisfy 37 C.F.R. §1.63 which provides that a newly executed oath or declaration is not required in a continuation or divisional application satisfying the conditions in 37 C.F.R. §1.63(d)(1)(i)-(iv). It is Applicant's understanding that, in the instant case, 37 C.F.R. §1.63 can be satisfied by submitting a copy of the executed oath or declaration filed in the parent application, or a newly executed oath or declaration. In order to expedite prosecution, Applicant has enclosed a copies of the executed oath/declarations filed in the parent application (Exhibits 2 and 3). Please note that the original oath/declaration specifically identified Claims 1 and 12 as being too narrow.

Applicant respectfully submits that the ground for rejection under 35 U.S.C. §251 has been obviated. Withdrawal of the rejection to claims 30-34 is respectfully requested.

CLAIM OBJECTIONS

Claim 30 is objected to for containing the word “lest.” Claim 30 has been amended to replace the word “lest” with the word “least.”

CLAIM REJECTIONS

Claims 30-34 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,673,609 to Hill (hereinafter “Hill”). Applicant respectfully traverses the rejection.

For anticipation under 35 U.S.C. §102, the reference “must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present.” (MPEP §706.02, IV. Distinction between 35 U.S.C. 102 and 103, page 700-21). The Federal Circuit has held that prior art is anticipatory only if every element of the claimed invention is disclosed in a single item of prior art in the form literally defined in the claim (*Jamesbury Corp. v. Litton Indus. Products*, 756 F.2d 1556, (Fed. Cir. 1985); *Atlas Powder Co. v. DuPont*; 750 F.2d 1569, (Fed. Cir. 1984); *American Hospital Suppl v. Travenol Labs*, 745 F.2d 1 (Fed. Cir. 1984).

Independent claim 30 of the instant application is directed to a see-through window article of manufacture, comprising: a substrate through which visible light can pass; a first coating formed on at least a portion of said substrate, said first coating being relatively opaque to passage of visible light; and a second coating formed on at least a portion of said substrate comprising a pattern that changes as a function of intensity of ambient visible light, wherein a perimeter region of said first coating is in alignment with a perimeter region of at least a portion of said second coating and wherein a person viewing said window article from a first surface thereof can see through at least a portion of said substrate, wherein a person viewing said window article from a second surface thereof see substantially said pattern.

Hill generally describes a panel which comprises a substrate of transparent or translucent material having applied to one or both sides a design superimposed on, or forming part of, an opaque pattern so that the design on one side of the panel cannot be seen from the other side. Hill, however, does not disclose, explicitly or impliedly, “a second coating formed on at least a portion of said substrate comprising a pattern that changes as a function of intensity of ambient visible light,” as recited in claim 30. Accordingly, Applicant respectfully submits that Hill does not anticipate claim 30 because it fails to teach every aspect of the claimed invention. Applicant

further submits that claims 31-34 are patentable over Hill because they depend from claim 30 and recite additional patentable subject matter. Withdrawal of the rejection under 35 U.S.C. §102(b) is respectfully requested.

CONCLUSION

In view of the above amendment and remarks, Applicant believes that the objection against this application has been fully addressed and that the application is now in condition for allowance. Therefore, issuance of a notice of allowance for the application is respectfully requested. Should additional fees be needed in connection with this amendment, the Commissioner is authorized to charge any additional fees to Deposit Account No. 50-2849.

Respectfully submitted,

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Enclosures: Exhibit 1: Written Consent
Exhibit 2: Re-issue declaration of Gregory E. Ross, filed November 3, 2000
Exhibit 3: Supplemental Re-issue declaration of Gregory E. Ross, filed November 29, 2001